

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No.: 14337US02

PATENT

In the Application of:)	
)	
Jeyhan Karaoguz, et al.)	<u>Electronically Filed On January 20, 2009</u>
)	
Serial No.: 10/672,251)	
)	
Filed: September 26, 2003)	
)	
For: MEDIA PROCESSING SYSTEM)	
SUPPORTING AUTOMATED)	
PERSONAL CHANNEL)	
CONSTRUCTION BASED ON USER)	
PROFILE AND PRE-SELECTION)	
)	
Examiner: Long, Andrea Natae)	
)	
Group Art Unit: 2176)	
)	
Confirmation No.: 8832)	

REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Paper responds to the Examiner's Answer mailed November 25, 2008. The Applicants respectfully request that the Board of Patent Appeals and Interferences reverse the final rejection of claims 1-53 of the present application. The Paper is timely because it is being filed within two months of the November 25, 2008 mailing date of the Examiner's Answer.

REMARKS

As noted in the Manual of Patent Examining Procedure (Revision 7, July 2008), “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” See MPEP at 2143.03. Further, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA).” See *id.*

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure, Rev. 6, Sep. 2007 (“MPEP”) states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Additionally, if a *prima facie* case of obviousness is not established, the Applicants are under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142. Thus, it is the responsibility of the Examiner (but not the Applicants to perform the job of the Examiner) to show that the cited references, namely, Nash and Cristofalo, describe, teach or suggest all the claim limitations. Moreover, such a *prima facie* showing cannot be supported by “mere conclusory statements.”

I. The Proposed Combination Of Nash And Cristofalo Does Not Render Claims 1-53 Unpatentable

The Examiner’s Answer states the following:

The Appellant is placing weight on the term “user-defined profile” as if the profile is created through a user interface where the user manually sets requirements such as age, gender, user interest, etc., however the specification lacks support for where the user-defined profiles is in fact created by the user explicit selection of interests.

See Examiner’s Answer at page 19.

The present application discloses, however, that the “MES platform 107 also provides the functional capability for a user of the MPS 101 to generate a user profile 111, using, for example, a remote control that interacts with the MPS 101.” See present application at page 14, lines 11-13 (emphasis added). “Similarly, the MES platform in home PC 102 also provides the functional capability for a user of the home PC 102 to generate a user profile using, for example, a mouse or keyboard that interacts with the PC 102....” See *id.* at page 14, lines 13-16 (emphasis added). Thus, the present application clearly provides support for a user generating a user profile using a remote control, a mouse or keyboard.

So it is clear that the present application describes a user generating a user profile. That is, the present application clearly discloses a user-defined profile. The present application also discloses the types of information within the profile generated by the user, *i.e.*, the user-defined profile. For example, the present application clearly and unequivocally states the following:

The user profile 111 [which is generated by the user using, for example, a remote control, mouse or keyboard per the present application at page 14, lines 11-16] may comprise a file that **includes various information about the user of the MPS 101**. For example, the user profile 111 may include various interests of the user, the various interests of the user's kids and spouse, ages of the user and the user's spouse and kids, hobbies of the user, gender of the user and the user's spouse and kids, past history of viewing by the user, a genre, a media type, a media format, a media quality, a time, and a media selection.

See id. at page 14, line 18 to page 15, line 3 (emphasis added). Thus, the present application discloses that a user may use a remote control, keyboard or mouse to generate a profile that includes such things as the user's interests, his/her kids' interests, the age of the user, hobbies, etc. Clearly, the MPS cannot determine the user's age, kids' ages, etc. Instead, the user is defining his/her profile in such a manner. As detailed above, contrary to the statement in the Examiner's Answer, the present application provides clear and unequivocal support for a "user-defined profile."

The Applicants demonstrate that the proposed combination of Nash and Cristofalo does not describe, teach or suggest automatic selection of media according to a user-defined profile. *See* Appeal Brief at pages 8-13. Thus, the Applicants maintain that the proposed combination does not render claims 1-53 unpatentable.

II. A *Prima Facie* Case Of Obviousness Has Not Been Established With Respect To Claims 47-53 For An Additional Reason

The Applicants note that the Office Action does not establish a *prima facie* case of obviousness with respect to claims 47-53 for an additional reason. *See* Appeal Brief at page 13. In particular, the Applicants point out that the Office Action does not even attempt to indicate where the cited references describe, teach or suggest a user "sending" a user-defined profile

somewhere, as recited in claim 47. *See id.* In response to this challenge to cite something specific (*i.e.*, a cite to a paragraph) from the references that would tend to disclose this limitation, the Examiner's Answer states the following:

Appellant argues that cited references fail to teach "sending by a user a user-defined profile".

The Examiner disagrees.

As similarly addressed above, Nash teaches two method of creating a user-defined profile. The user can use a menu selection for define the user profile, thereby sending information to the system for which media to retrieve to match the user's interest. Additionally the profile is sent by the user through selection by a remote control by the user of media of interest that creates profiled information for accessing additional media of interest.

See Examiner's Answer at page 20.

Initially, the Applicants do not concede that Nash discloses a "user-defined profile," as made manifestly clear in the Appeal Brief at pages 8-13. Further, and most notably, the Examiner's Answer still does not cite anything specific from the references that would tend to disclose a user "sending" a user-defined profile somewhere. Clearly, if either of the references did disclose a user sending a profile somewhere, the Examiner's Answer could have easily noted that particular paragraph in the response above. However, the Examiner's Answer is devoid of any such citation.

Further, the Examiner's Answer notes "sending information" that is ultimately used by the "system" to create a profile for a user. The response above makes no mention of the user his/herself sending his/her profile anywhere. Instead, the response above notes that the "profile is sent by the user ... that creates profiled information." The Examiner's Answer seemingly meant to say that "information," as opposed to "the profile" is sent by the user that "creates

profiled information.” Clearly, a profile does not create itself (*i.e.*, a “profile” does not create “profiled information”). Again, though, neither the Office Action, nor the Examiner’s Answer provides any citation from any of the references to support the conclusory statements noted above.

For at least these reasons and those set forth in the Appeal Brief at page 13, the Applicants respectfully maintain that neither the Office Action, nor the Examiner’s Answer, establishes a *prima facie* case of obviousness with respect to claims 47-53.

III. A *Prima Facie* Case Of Obviousness Has Not Been Established With Respect To Claims 18, 27, 45 and 53 For An Additional Reason

Claim 18 recites “wherein the server software supports **anonymous** media exchange.” Claims 27, 45 and 53 recite similar limitations. The Office Action and the Examiner’s specifically cite to only Cristofalo at ¶¶ [0029] and [0034] as disclosing this limitation. *See* June 23, 2008 Office Action at pages 7, 10, 14 and 15 and Examiner’s Answer at page 8, 11, 15 and 16. The Applicants demonstrate, however, that these cited portions of Cristofalo do not, describe, teach or suggest “anonymous media exchange,” or “wherein the user is unknown to the source.” *See* Appeal Brief at page 13-14. Thus, for at least these reasons, neither the Office Action, nor the Examiner’s Answer establishes a *prima facie* case of obviousness with respect to claims 18, 27, 45 and 53.

III. CONCLUSION

For at least the reasons discussed in the Appeal Brief and above, the Applicants respectfully submit that the pending claims are allowable in all respects. Therefore, the Board is respectfully requested to reverse the rejections of pending claims 1-53.

The Commissioner is authorized to charge any necessary fees, or credit any overpayment to Deposit Account 13-0017.

Dated: January 20, 2009

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